

Appln No. 09/866,546

Amdt date March 7, 2005

Reply to Office action of December 7, 2005

REMARKS/ARGUMENTS

In the Office action dated December 7, 2004, claims 3 - 8, 14 and 20 were rejected under 35 U.S.C. § 112, claims 1, 2, 9 - 11 and 15 - 17 were rejected 35 U.S.C. § 102 and claims 3 - 8, 12 - 14 and 18 - 20 were rejected under 35 U.S.C. § 103. By this amendment claims 1 - 8, 14 and 20 have been amended. Claims 1 - 20 are pending in the application.

Response to the Rejection of Claims 3 - 8 Under 35 U.S.C. § 112.

Claims 3 - 8 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Office action stated that the terms "Bluetooth" and "HomeRF" in claims 3 - 8 are trademarks or trade names that are used to identify/describe different types of operating systems and software application. Applicant believes that the use of the terms in the original claims is not a trademark or trade name use, rather the claims as they would be understood by one skilled in the art relates to well known communication standards, not mere trademarks or trade names. Nevertheless, in an attempt to expedite resolving the issues in this case, Applicant has amended claims 3 - 8 to more clearly recite the standards-based limitations of the claims.

The Office action also stated that the use of the term "802.11b" in claims 6 - 8 create an indefinite situation on the grounds that standards are always subject to interpretations and are constantly being updated.

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Applicant respectfully traverses this § 112(2) rejection of the claims. The Office is asked to reconsider and withdraw those rejections. Among other things, such rejections are inconsistent with Office practice over many years, and they call into question the validity of numerous issued patents having claims which identify, one way or another, many different standards including Bluetooth, 802.11 and HomeRF standards as well as any other standards that are well known in the context of computer communications. In that regard, the Office may find it useful to review the Appendix attached hereto, which is a collection of printouts from the Office's own internet web site showing the results of searches for the occurrence of the standards named above in the claims of issued US patents for "all years", namely, 1975 to the present. The reports in the Appendix are summarized as follows:

<u>Search Term</u>	<u>No. of Patents having claims in which the search term appears</u>
Bluetooth	301
802.11	88
HomeRF	16

MPEP § 1700 is titled "Office Personnel Not To Express Opinion on Validity or Patentability of Patent". The Office's § 112 rejection of applicant's claims 3 - 8 is effectively an attack on the validity of each of the patents comprising the search results evidenced by the Appendix. The § 112 rejection is manifestly inconsistent with Office practice over many years.

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Moreover, Applicant's claims 3 - 8 are not indefinite under the principles stated in MPEP §§ 2171-2174. Section 2171 defines "definite" as "whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art." Section 2173.02 (page 2100-205) lists factors A-C as measures of claim definiteness. The conditions of each of those factors are met in the instance of claims 3 - 8.

The Office's assertion that "standards can change over time" may be true as to cultural standards, but is believed rarely to be true as to the essence of technical or engineering standards. The standards identified in claims 3 - 8 are standards which assure the functional connection compatibility of communication equipment so a wide variety of communication equipment that supports the standard may communicate with one another. While these standards may be revised periodically to reflect advances in technology, their essential requirements addressing the functional criteria for signal transmission compatibility remain unchanged since this is necessary to ensure that equipment originally designed to operate with other equipment that meet the standard will continue to do so as long as the standard is in existence. Indeed, the very nature and purpose of the standard, to maintain compatibility between devices, ensures that one skilled in the art will understand what is meant by a "network that operates in accordance with the [Bluetooth, HomeRF or 802.11b] standard" as claimed. In view of the above, Applicant submits that the section 112 rejections of claims 3 - 8 be withdrawn.

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Claims 14 and 20 were rejected on the grounds that "wherein each scan" is not clear as to whether it is referring to each window scan or each multiple scan inside each window scan. Applicant believes that the original meaning of the claims is clear given that the specific term "scan" (as opposed to "scanning") was used in the context of the scans of claims 13 or 19. Nevertheless, in an attempt to expedite resolving the issues in this case, Applicant has amended claims 14 and 20 to more clearly recite this limitation.

Response to the Rejection of the Claims Under 35 U.S.C. § 102

Claims 1, 2, 9 - 11 and 15 - 17 were rejected under 35 U.S.C. § 102(B) as being anticipated by Devon, U.S. Patent No. 5,546,211. Claims 1 and 2 are independent claims.

Claim 1 and 2, as amended, are respectively directed toward a method and controller for "managing wireless network access for a wireless RF communication device." In contrast, Devon is directed toward infrared communication devices. Accordingly, Devon does not teach or suggest all of the limitations of independent claims 1 and 2.

Claims 9 - 11 and 15 - 17 that depend on claims 1 and 2, respectively, also are patentable over the cited references for the reasons set forth above. In addition, these dependent claims are patentable over these references for the additional limitations that the dependent claims contain.

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Response to the Rejection of the Claims Under 35 U.S.C. § 103

Claims 3 - 8, 12 - 14 and 18 - 20 were rejected under 35 U.S.C. § 103. Claims 3, 5, 6, 8, 12 - 14 and 18 - 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Devon in view of Nevo et al., U.S. Patent No. 6,600,726 ("Nevo"). Claims 4 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Devon and Nevo in view of Hollstrom et al., U.S. Patent Application Publication No. 2001/0056502 ("Hollstrom"). Claims 3, 4, 6 and 7 are independent claims.

Applicant respectfully submits that there is no teaching in the art to combine the cited references in a manner that provides the inventions of independent claims 3, 4, 6 and 7. The Examiner's rejection is based on an implicit assumption that it would have been obvious to apply the sequential teachings of Devon to the systems of Nevo. As discussed in Applicant's last response Nevo discloses techniques that may be used during simultaneous communication with two networks. See, for example, Nevo at column 4, lines 13 - 15 ("Accordingly, wireless device 100 is able to operate with devices 104a and 104b of networks 108a and 108b in two wireless protocols at the same time"). To accomplish this, Nevo teaches that interference between these devices must be avoided through the use of filtering and dominant/dominated device techniques. There is no teaching in the references or known art, however, that sequential techniques would work in wireless RF networks as recited in the claims. Such a teaching is far from obvious, in part, because Devon and Nevo utilize entirely different communication components, protocols and signaling. As such,

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there would be no indication of any compatibility between such systems. Hence, there is no teaching or suggestion that techniques used in one system should or could be used in the other.

In view of the above, there is no teaching or suggestion that "sequentially performing network scans in accordance with the Bluetooth standard and network scans in accordance with the HomeRF standard" may be used in "selecting a network" and "establishing a connection with the selected network" as claimed in claims 3 and 4. Similarly, there is no teaching or suggestion that "sequentially performing network scans in accordance with the Bluetooth standard and network scans in accordance with the 802.11b standard" may be used in "selecting a network" and "establishing a connection with the selected network" as claimed in claims 6 and 7.

Claims 5 and 8 that depend on claims 4 and 7, respectively, also are patentable over the cited references for the reasons set forth above. In addition, these dependent claims are patentable over these references for the additional limitations that the dependent claims contain. For example, the cited references do not teach or suggest that it may be possible to use common circuitry in a method that incorporates sequential scans of different networks.

Claims 12 - 14 and 18 - 20 that depend on claims 1 and 2, respectively, also are patentable over the cited references for the reasons similar to those set forth above. In addition, these dependent claims are patentable over these references for the additional limitations that the dependent claims contain.

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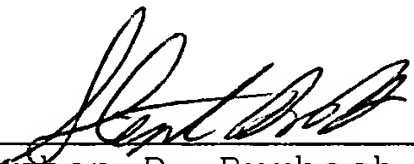
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For example, none of the cited references or known art make any reference to "performing multiple scans" during multiple scanning windows as claimed in claims 13 and 19.

CONCLUSION

For the foregoing reasons Applicant submits that the claims are patentable over the references of record. Reexamination and reconsideration are respectfully requested.

Respectfully submitted,
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